



**UNITED STATES DEPARTMENT OF COMMERCE**  
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/930,235

02/23/98

EITRICH

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EXAMINER

LOVERING, R

ART UNIT

PAPER NUMBER

1712

17

DATE MAILED:

02/07/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

08/930,235

Applicant(s)

EITRICH ET AL.

Examiner

LOVERING

Group Art Unit

1712

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☒ Responsive to communication(s) filed on APR 11 + OCT 10, 2000
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1-3 is/are pending in the application.
- Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1-3 is/are rejected.
- ☒ Claim(s) 2 AND 3 is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other \_\_\_\_\_

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### DETAILED ACTION

1. The request filed on October 10, 2000 for a Continued Prosecution Application (CPA) under 37 CAR 1.53(d) based on parent Application No. 08/930,235 is acceptable and a CPA has been established. An action on the CPA follows.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Schambil et al. DE 4,010,393 esp. Beispiele; Table 1; and abstract)

As to the expression " $\leq 11.85\%$  by weight of" an oil phase in claims 1 and 3, it is well-settled that limitations which are new matter cannot be considered in passing on claims. See In re Mims, 56 U.S.P.Q536; 553 O.G.6.

4. Claims 1-3 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Allard et al. 5,616,331 of record.

The instantly-claimed transparent or translucent micro emulsions and process for preparing them are anticipated by Allard et al. (esp. Ex 1; paragraph bridging col's. 2 and 3; col. 5, lines 47-65; and col. 6, lines 39-47), or are at least already within the <sup>ur</sup>view of Allard et al., and thus would have been obvious therefrom to one having ordinary skill in the art at the time applicants' invention was made. As stated in the preceding paragraph, as to the expression " $\leq 11.85\%$  by weight of" an oil phase in claims 1 and 3, it is well-settled that limitations which are new matter cannot be considered in passing on claims. See the Mims decision cited above. Even

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if the quoted expression were considered, it is evident from Allard et al. (col. 5, lines 28-43, esp. lines 34-36) that patentees contemplate the use of as little as 5% oily phase, and it would have been obvious to one skilled in the art to use such a low oily phase concentration in the micro emulsions of Allard et al. to render them less expensive by reducing the amount of oily phase relative to the aqueous phase.

5. Claims 2 and 3 are objected to for using passive instead of active form verbs.

6. Claims 1-3 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The expression " $\leq 11.85\%$  by weight" of an oil phase lacks antecedent basis and support in the disclosure, and is considered new matter. The oil phase ingredients in Ex. 4 do not add up to 11.85%.

7. Applicant's arguments filed August 29, 1999 have been fully considered but they are not persuasive. Schambil et al. (page 3, line 57) indicate that their micro emulsions are transparent. The issue concerning the oil phase concentration has been dealt with above herein.

8. The disclosure is objected to because of the following informalities: the specification lacks:

-- BRIEF DESCRIPTION OF DRAWINGS --

Appropriate correction is required.

9. Any inquiry concerning this communication should be directed to Examiner Lovering at telephone number (703) 308-0443.

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Lovering/dh

January 28, 2001

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